



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,151	10/12/2000	John J. Sie	85312-621601	8606

20350 7590 05/16/2011
KILPATRICK TOWNSEND & STOCKTON LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
----------	--------------

2424

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

05/16/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docket@kilpatricktownsend.com
ipefiling@kilpatricktownsend.com
jlhice@kilpatrick.foundationip.com

Office Action Summary	Application No. 09/687,151	Applicant(s) SIE ET AL.	
	Examiner REUBEN M. BROWN	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13,21,22,25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-13,21,22,25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/26/11</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-13, 21-22, 25 & 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proehl, (U.S. Pat # 6,990,676), in view of Inoue, (U.S. Pat # 5,884,141) and Hodge, (U.S. Pat # 6,938,268).

Considering claim 1 & 31-34, the amended claimed method for receiving a program by a user location that is sent from a content distributor, comprising;

Art Unit: 2424

'receiving the program at the user location as a first linearly scheduled program near video on demand, NVOD program, which is multicasted and can be viewed on a first channel', is met by the disclosure of Proehl that a user selects regular broadcast programming for display on the TV screen, see Abstract; Fig. 13A; Fig. 13B; col. 14, lines 26-67.

As for the claimed, *'processing and storing a first portion of the program at the user location'*, and *'detecting a user request for the program after storage of the first portion and receiving a second portion of the program in response to the user request'*, Proehl discusses that graphics images such as still shots from the instant program or short video clips related to the program, etc. may be downloaded and stored on the hard drive of the user's terminal equipment, Abstract; col. 15, lines 1-18. Proehl goes on to discuss that if the user selects a linearly scheduled broadcast program that is currently being broadcast, that the system presents the user with the instant broadcast program. However, these graphics images, (such as short video clips) will be presented to the user when a linearly scheduled broadcast program is selected that is scheduled to be broadcast in the future from the current date/time, which is different from the recited claims.

Nevertheless, Inoue provides a teaching of, receiving and storing a lead-in segment of a movie/program Fig. 1; col. 8, lines 35-47. In particular, this passage of Inoue teaches that when a viewer chooses certain NVOD movies, the first segment of the instant NVOD movie is read out from a buffer at the viewer site, while the remaining portion of the instant movie is being transmitted. Therefore the combination of Proehl & Inoue meets the claimed subject matter.

Art Unit: 2424

The combination of Proehl & Inoue provides for the system to download short clips, such lead-ins for different programming services, such as linearly scheduled broadcast programs, including NVOD programs. Once a customer selects a particular broadcast program, then a lead-in segment is initially played from the user's terminal equipment, with the remaining portion coming from the regular broadcast. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Proehl with the feature of presenting the first portion of a program from downloaded segments, at least for the desirable advantage of overcoming any delay/hiatus created by time consumed in any downloading/transmission processing, at the beginning of scheduled broadcast, such as NVOD, as taught by Inoue, col. 2, lines 25-40.

As for the amended claimed feature of: *'wherein the first portion is at least one eighth of the program'*, Proehl only discusses images as "short clips", without examples of the duration, whereas Inoue discusses that the lead-in segment should be at least as long as the broadcasting interval between channels carrying the program, see col. 8, lines 59-65. Official Notice is taken that at the time the invention was made, access to larger memory units/cache was well known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Proehl & Inoue with the well-known technology of expanded memory capacity, which enables longer durations of the lead-in segments to be stored on the receiver, for example such as an hour or more, at least for the desirable improvement of expanding the time available for the system to transmit the rest of the program to the consumer.

Art Unit: 2424

The first portion being at the beginning of the program, reads on Inoue, col. 9, lines 1-15.

'receiving a second portion in response to detecting the user request, wherein the second portion is received on a different channel from the first channel, and the second portion comprises a remaining portion of the program subsequent to the first portion', Inoue, (col. 9, lines 1-40) teaches that the remaining portion of NVOD is generally transmitted after the subscriber requests, and that the remaining portions may be transmitted on different NVOD channels, namely, CH1-CH7. Nevertheless Hodge, in the same field of endeavor provides a reference that teaches a first portion of a movie being received as a NVOD broadcast, whereas a second, subsequent portion of the movie being received as a VOD transmission dedicated to a particular customer, see col. 8, lines 51-67 thru col. 9, lines 1-10. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Proehl & Inoue with the teachings of having a first portion of a movie transmitted in NVOD and a second subsequent portion of the instant move transmitted as a VOD, for the desirable advantage of combining the advantages of shared bandwidth of NVOD with the advantages of personal movie control, as taught by Hodge, see Abstract & col. 1, lines 25-65 & col. 2, lines 1-67.

'storing the second portion at the user location', reads on Inoue col. 3, lines 59-63; col. 7, lines 31-48; col. 8, lines 1-51.

Art Unit: 2424

As for the additionally feature, *'wherein the first portion of the program is part of a linearly scheduled NVOD schedule of the plurality of channels... the plurality of channels including the first channel & second channel... the second portion is received as a singlecast media, further wherein the singlecast media is a digital channel transmitted exclusively to the user location'*, the linearly scheduled programming of Proehl (col. 14, lines 35-60) and Inoue (col. 8, lines 35-47) meet claimed *'multicast media'*. However, the claimed *'singlecast media'*, as further defined in the claims reads on the disclosure of Hodge, already discussed above, since it is disclosed that upon executing the video-motion-control function, the user is removed from the shared stream and given a private stream.

It is noted that the Hodge discussed that the private stream given to a particular user is only as long as is need by the instant user. However, the claims states that *'the second portion comprise a remaining portion of the program subsequent to the first portion'*, and is thus broad enough to read on the disclosure of Hodge. It is further noted that Hodge employs a sophisticated algorithm to minimize/maximize the space allocated to particular movies, and thus the space available to transmit the second portion private stream to a particular customer is a matter of a business decision, not a technical question.

Considering claims 2 & 11, if the viewer's home equipment has downloaded and stored a lead-in segment of the movie that the viewer has just selected, then the lead-in segment is retrieved from the receiver and begins to be displayed for the viewer; see Inoue, Abstract; col. 8, lines 45-67.

Considering claims 3 & 12, the instant claims recite that a *'first time associated with playing the first portion is equal to or greater than a second time associated with receiving or transmitting a second or plurality of portions'*, reads on the disclosure that the duration should be at least as long as the time between intervals, Inoue col. 8, lines 55-67.

Considering claim 4, the claimed subject matter reads on the operation of the remote controller 14 of Proehl, which used infrared technology, col. 9, lines 52-64.

Considering claim 13, the programs in Inoue that include a lead-in segment read on the recited programs consisting of a first and second portion; col. 8, lines 12-67. Thus, the combination of Proehl & Inoue meets the claimed subject matter.

Considering claim 6, the claimed set-top box reads on the integrated receiver 12 of Proehl, Fig. 1; col. 4, lines 15-67 & col. 5- col. 7 and the receiver of Inoue, Fig. 1.

Considering claim 7, the claimed mass storage device reads on the HDD 228 of Proehl, col. 6, lines 1-35; col. 15, lines 1-18. Inoue stores the pre-storage NVOD on a hard disk, col. 9, lines 1-15.

Considering claim 8, the claimed feature of *'determining a subset of programs from a linear schedule of programs and dividing each of the subset of programs into a respective first*

Art Unit: 2424

and second respective portion’ reads on the server in Inoue transmitting the lead-in segments for certain movies, col. 8, lines 48-65. It is disclosed that lead-ins are only generated for “different programs”, which reads on *‘determining a subset of programs’*. The additionally claimed feature of transmitting a plurality of the respective first portions to the user location is also met by the above-cited disclosure of Inoue.

Considering claim 9, subject matter that corresponds with limitations discussed in claim 1, are likewise treated. Inoue teaches that a certain of the programs at a central station 10, have lead-in segments, which in combination with Proehl, reads on the claimed *‘determining a linear schedule of content programs, wherein each content comprises a first segment and a second segment’*; see col. 2, lines 1-8, since Inoue is directed to NVOD with linearly scheduled programming, see Figs 2A; 2B; 3A; 3B. 4A; 4B.

The additional step of storing a second set of segments remotely from user location reads on the server in Inoue, which inherently stores NVOD moves before they are transmitted. The additionally claimed features of, *‘transmitting and storing a first set of segments to the user location, and transmitting one of the second set of segments to the user location, after a request from the user’* is met by col. 3, lines 1-30; col. 4, lines 12-35 & Fig. 5.

As for the amended claimed feature: *‘wherein the first segment is at least fifteen minutes’*, represents a logical extension of the subject matter found in claim 1, and is likewise analyzed.

Art Unit: 2424

Considering claim 10, the claimed feature of transmitting a commercial to the user location reads on the disclosure of Inoue of downloading trailers or previews to the subscriber; col. 9, lines 31-40.

Considering claims 21 & 22, the claimed features correspond with subject matter mentioned above in the rejection of claims 1 & 9, and are likewise treated.

Considering claim 25, the claimed subject matter is also met by the combination of Proehl & Inoue.

Considering claim 27, the claimed, '*plurality of portions*' on a '*second and third channel*' is met by Inoue, col. 6, lines 35-67 thru col. 7, lines 1-30; col. 9, lines 11-22.

Considering claim 28, the combination of Proehl & Inoue plays the lead-in segment, and then the remaining program, which meets the claimed subject matter.

Considering claim 29, Inoue teaches that the first portion may be transmitted on a different channel from the NVOD channels, col. 8, lines 48-65.

Considering claim 30, the claimed features correspond directly with subject matter mentioned above in the rejection of claims 1, 3, 9 & 24, and are likewise treated.

Art Unit: 2424

As for the amended feature of storing one of the second sets, Inoue teaches that portions may be stored simultaneous with the delivery of the NVOD program in order to playback during a pause, col. 6, lines 12-67.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's claims.

A) Li Teaches a system that uses NVOD and VOD transmission of the same program to a particular customer, see col. 4, lines 49-67.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2424

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pankaj Kumar can be reached on (571) 272-3011. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Pankaj Kumar/

Supervisory Patent Examiner, Art Unit 2424